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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/725,494	11/30/2000	Jose Ignacio Zorrila De San Martin Soto	2585-0112P	8882

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EXAMINER

KAZIMI, HANI M

ART UNIT PAPER NUMBER

3624

DATE MAILED: 08/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/725,494

Applicant(s)

ZORRILA DE SAN MARTIN SOTO
JOSE IGNACIO

Examiner

Hani Kazimi

Art Unit

3624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. This application has been reviewed. Original claims 1-20 are pending. The objections and rejections cited are as stated below:

Claim Rejections - 35 U.S.C. 101

2. 35 U.S.C. 101 reads as follows:

"Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter or any new and useful improvement thereof, may obtain a patent therefore, subject to the conditions and requirements of this title".

3. Claims 1-15 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

35 USC 101 requires that in order to be patentable the invention must be a "new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof" (emphasis added).

Claims 1-15 are rejected under 35 U.S.C. 101 because; the claimed invention is directed to a non-statutory subject matter. Specifically the method claims as presented do not claim a technological basis in the pre-amble or the body of the claim. Without a claimed basis, the claim may be interpreted in an alternative as involving no more than a manipulation of an abstract idea and therefore non-statutory under 35 U.S.C. 101. In contrast, a method claim that includes in the body of the claim structural / functional

interrelationship which can only be computer implemented is considered to have a technological basis [See Ex parte Bowman, 61 USPQ2d 1669, 1671 (Bd. Pat. App. & Inter. 2001) - used only for content and reasoning since not precedential].

In order to overcome the 101 rejection above, the following preamble is suggested:

A computer implemented method for ---, or something similar. Also, in the body of the claim include structural / functional interrelationship which can only be computer implemented. Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

5. Claims 1, 2, 4, 6-8, 11-14, and 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Novogrod US Pat. No. 6,119,931.

Claims 1, 2, 4, 6-8, 11-14, and 16-20, Novogrod discloses a method, and a corresponding system for transferring money orders from a remitter to a payee, comprising the steps of providing a remitter with a pre-paid money order receipt, associating transaction data with said receipt, receiving money order receipt transaction data from said remitter, maintaining a database of money order transaction data associated with money order transaction receipts, determining if the transaction data submitted by said remitter is valid, if the transaction data submitted by the remitter is valid, activating the money order transaction in said database, receiving money order transaction data from said payee, determining if the transaction data submitted by said payee is activated in the database, and if the transaction data is determined to be activated, delivering to said payee the amount of funds pre-paid by the remitter (abstract, figs 14-18, column 2, lines 6-41, and column 18, line 6 thru column 22, line 37).

Novogrod teaches the use of a communication network, a telephone, an automated teller machine, and the Internet (abstract, and column 1, lines 5-15), and the step of associating transaction data with said receipt comprises printing said data on said receipt, comparing the data submitted by the remitter with data previously stored in the database, comparing the data submitted by the payee with data previously activated in said database (Figs 14-18, and column 18, line 6 thru column 22, line 37).

Claim Rejections - 35 USC ' 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent May not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

8. Claims 5, 10, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novogrod (U.S. Patent No. 6,119,931).

Claims 5, 10, and 15, Novogrod fails to teach the step of informing said remitter, in an international money order transaction, of the applicable exchange rate and the

exact amount that will be delivered to the payee, and that the data imprinted on the receipt and hidden by a scratch-off film.

Official Notice is taken that applicable exchange rate in an international transaction, and scratch-off film cards are old and well known in the art. It would be obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Novogrod to include the step of informing said remitter, in an international money order transaction, of the applicable exchange rate and the exact amount that will be delivered to the payee, and that the data imprinted on the receipt and hidden by a scratch-off film because, it greatly improves the efficiency of the system by including the exchange rate in the transfer, and a more secure system.

9. Claims 3, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Novogrod (U.S. Patent No. 6,119,931) in view of Levine et al. (U.S. Patent No. 5,477,038).

Claims 3, and 9, Novogrod fails to teach that the receipt comprises a money order card, and the use of at least two control numbers.

Levine teaches that the receipt comprises a money order card, and the use of at least two control numbers (abstract, column 2, lines 6-65, and column 4, line 29 thru column 7, line 45).

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millin can be reached at (703) 308-1065.

The fax number for Formal or Official faxes and Draft or Informal faxes to Technology Center 3600 or this Art Unit is (703) 305-7687 or 7658.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-1113 or 1114.



HANI M. KAZIMI
PRIMARY EXAMINER

Art Unit 3624

July 26, 2004